Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MICKEY LEE SMITH,
CYNTHIA STEWART STOKES,
and
RONNIE LEE WILLARD

_____

Appeal No. 2000-1121
Application No. 08/827,656

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ON BRIEF

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Before KIMLIN, GARRIS, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 26-30, 35 and 36 which are all of the claims remaining in the application.

The subject matter on appeal relates to an article for use as an anti-static device in a clothes dryer comprising a rod made of a gathered web or filamentary tow substrate

wherein the rod is overwrapped with a sheet material and an anti-static additive is incorporated in the rod. This appealed subject matter is adequately illustrated by independent claim 26 which reads as follows:

> 26. An article for use as an anti-static device in a clothes dryer to inhibit static electricity that causes the items of clothing to cling to one another, comprising a rod formed with the shape and appearance of an elongated cigarette filter having a longitudinal axis, two ends and being made of a gathered web or filamentary tow substrate extending from end to end of said rod, said rod being overwrapped with a sheet material overwrap, and an
> anti-static additive incorporated in said rod.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Cline	4,420,002	Dec. 13, 1983
Rutherford	5,069,231	Dec. 3, 1991
Morris et al. (Morris)	5,145,595	Sep. 8, 1992

Claims 26, 29, 35 and 36 stand rejected under 35 U.S.C. § 102(b) as anticipated by or alternatively under 35 U.S.C. § 103 as obvious over Rutherford.

Claims 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rutherford in view of Cline, and claim 30 stands correspondingly rejected as being unpatentable over

Rutherford in view of Morris.

We cannot sustain any of the above-noted rejections.

With respect to the Section 102 rejection, the examiner contends that the article shown in Figure 1a and described, for

example, in column 3 of Rutherford "fully meets the requirements of Claim 26" (answer, page 4). More specifically, the examiner states: "It appears from Figure 1a [of Rutherford] that the shape and appearance of the article is like that of an elongated cigarette filter, having a longitudinal axis, two ends and being made of a gathered web or filamentary tow substrate extending from end to end of the rod" (answer, page 4; emphasis added). As correctly argued by the appellants, however, patentee's articles "clearly do not meet the language of claim 26 that the rod is 'made of a gathered web or filamentary tow substrate extending from end to end of said rod, said rod being overwrapped with a sheet material overwrap'" (brief, pages 6-7; emphasis added). This is because the article of Rutherford including its "substrate" or core is made of extruded polymer (e.g., see the paragraph bridging columns 10 and 11) rather than "a gathered web or filamentary tow" as required by appealed independent claim 26.

Under these circumstances, we cannot sustain the examiner's Section 102 rejection of claims 26, 29, 35 and 36

as being anticipated by Rutherford.

Concerning the Section 103 rejection based on Rutherford alone, the examiner states that "since Rutherford teaches that these articles can be used for a variety [of] products and that in another embodiment of the invention these articles can be incorporated into filters (such as those used in cigarettes); column 3, lines 40-45, and since it is taught that filters (such as those used in cigarettes) are known to be wrapped in paper (col. 9, lines 20-25, Figure 4, #15) then it would have been obvious to put an anti-static rod-like article in a filter that is wrapped in paper; for use i.e.[,] in the laundry, not for use with a smokable cigarette" (answer, page 5). Like the appellants, we regard the examiner's conclusion of obviousness as not well founded.

It is well settled that obviousness under Section 103 requires a suggestion to modify the prior art in the manner proposed by the examiner. In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). The mere fact that the prior art could be modified (i.e., in such a manner as to achieve the claimed invention) would not have made the modification obvious unless the prior art suggested the

desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In light of these legal principles, it is apparent that the examiner has failed to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. This is because Rutherford simply does not contain any suggestion "to put an anti-static rod-like article in a filter that is wrapped in paper" as proposed by the examiner. In re O'Farrell, Id. Thus, while patentee's article containing an anti-static additive could be placed in a filter (such as used in cigarettes), such a modification would not have been obvious because Rutherford would not have suggested the desirability of the modification. In re Gordon, Id.

Notwithstanding a thorough consideration of the examiner's obviousness position, we are convinced that the Section 103 rejection over Rutherford alone is based upon impermissible hindsight wherein that which only the inventor has taught is
used against its teacher. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the

Section 103 rejection of claims 26, 29, 35 and 36 as being unpatentable over Rutherford cannot be sustained.

The examiner has not contended and we do not consider the above-discussed deficiencies of Rutherford to be supplied by the additionally applied references to Cline and Morris. Accordingly, we also cannot sustain the examiner's Section 103 rejections of claims 27 and 28 as being unpatentable over Rutherford in view of Cline and of claim 30 as being unpatentable over Rutherford in view of Morris.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
BRADLEY R. GARRIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

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